

Atty. Dkt. No. 035451-0169 (3707.Palm)

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 7 and 32 are cancelled without prejudice.

Claims 1, 8, 16, and 24-31 are currently being amended.

No new matter has been added.

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate status identifier for each.

After amending the claims as set forth above, claims 1-6 and 18-31 are now pending in this application.

Claim Rejections – 35 U.S.C. § 103(a)

a. Rejection of claims 1-5, 7-13, 15-21, 23-29, and 32 based on Bork et al. in view of Barros et al.

In section 3 of the Office Action, claims 1-5, 7-13, 15-21, 23-29, and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bork et al. (U.S. Patent No. 6,246,376) in view of Barros et al. (U.S. Published Patent Application No. 2002/0147717).

i. Claims 1-5 and 7

With regard to claim 1, Applicant respectfully submits that the cited combination of Bork et al. in view of Barros et al. fails to disclose all of the steps of claim 1 as combined therein. Specifically, claim 1 has been amended to recite “selecting one or more of the listed identifiers and sharing information with the local area computing device corresponding to the chosen identifier.” This step was previously recited in former claim 7 (canceled herein without

Atty. Dkt. No. 035451-0169 (3707.Palm)

prejudice), which depended from claim 1. The cited combination of Bork et al. in view of Barros et al. does not teach, disclose, or suggest “selecting one or more of the listed identifiers and sharing information with the local area computing device corresponding to the chosen identifier” as included in the combination of steps of claim 1.

Bork et al. discloses only generally that the identification data “is entered manually or received through the cellular link when a certain number is called to page another like device 100” and that the identification data “is used throughout communications between the locating (paging) device 202 and the target (paged) device 204 as the paging device 202 approaches the paged device 204.” Col. 5, line 49 – col. 6, line 4. Thus, Bork et al. does not disclose that the identification code or codes are ever used for selection of a particular device with which to communicate information. The Office Action states with regard to claim 7 that “Bork discloses that one or more listed identifiers can be chosen for sharing of information (Col. 8, claim 7).” This citation in Bork et al., however, discloses only that touch sensitive information may be provided to meet the needs of users such as blind persons, and does not disclose the use of identifiers or sharing information with a device corresponding to the identifier. As to Barros et al., it fails to disclose any of the steps of claim 1 mentioned above that are lacking in Bork et al. et al.

Thus, the cited combination of Bork et al. in view of Barros et al. does not teach, disclose, or suggest “selecting one or more of the listed identifiers and sharing information with the local area computing device corresponding to the chosen identifier,” and particularly not as part of a “method of communicating between a handheld computer and other local area computing devices having wireless communication capability” when combined with the other steps of claim 1. Accordingly, Applicant requests that the rejection of claim 1 under 35 U.S.C. § 103(a) be withdrawn. Additionally, claims 2-5 depend from claim 1 and are thus patentable over the cited combination of references for at least the same reasons as claim 1, and Applicant further requests that the rejection of claims 2-5 under 35 U.S.C. § 103(a) be withdrawn as well.

Atty. Dkt. No. 035451-0169 (3707.Palm)

ii. Claims 8-13 and 15

With regard to claim 8, Applicant respectfully submits that the cited combination of Bork et al. in view of Barros et al. fails to disclose all of the steps of claim 8 as combined therein. Specifically, claim 8 has been amended to recite “wherein the wireless message includes information in addition to information necessary to sort the list.” The cited combination of Bork et al. in view of Barros et al. does not teach, disclose, or suggest “wherein the wireless message includes information in addition to information necessary to sort the list” as included in the combination of steps of claim 8.

The Office Action states that “Bork discloses that a message can be transmitted to one or more local area computing devices having wireless communication capability within the specified distance (Col. 4, lines 9-11).” Bork et al., however, discloses only the transfer of identification data and location data from one device to another. Thus, Bork et al. does not disclose communication of information beyond the information data required for determining location (i.e., the identification and location data). As to Barros et al., it fails to disclose any of the steps of claim 1 mentioned above that are lacking in Bork et al.

Thus, the cited combination of Bork et al. in view of Barros et al. does not teach, disclose, or suggest “wherein the wireless message includes information in addition to information necessary to sort the list,” and particularly not as part of a “method of sharing information between a handheld computer and a group of local area computing devices having wireless communication capability” when combined with the other steps of claim 8. Accordingly, Applicant requests that the rejection of claim 8 under 35 U.S.C. § 103(a) be withdrawn. Additionally, claims 9-13 and 15 depend from claim 8 and are thus patentable over the cited combination of references for at least the same reasons as claim 8, and Applicant further requests that the rejection of claims 9-13 and 15 under 35 U.S.C. § 103(a) be withdrawn as well.

Atty. Dkt. No. 035451-0169 (3707.Palm)

iii. Claims 16-21 and 23

With regard to claim 16, Applicant respectfully submits that the cited combination of Bork et al. in view of Barros et al. fails to disclose all of the elements of claim 16 as combined therein. Specifically, claim 16 has been amended to recite "wherein the wireless message includes information in addition to information necessary to sort the list." The cited combination of Bork et al. in view of Barros et al. does not teach, disclose, or suggest "wherein the wireless message includes information in addition to information necessary to sort the list" as included in the combination of elements of claim 16.

Bork et al. discloses only the transfer of identification data and location data from one device to another. Bork et al. does not disclose communication of information beyond the information data required for determining location (i.e., the identification and location data). As to Barros et al., it fails to disclose any of the steps of claim 1 mentioned above that are lacking in Bork et al.

Thus, the cited combination of Bork et al. in view of Barros et al. does not teach, disclose, or suggest "wherein the wireless message includes information in addition to information necessary to sort the list" and particularly not as part of a "local area wireless communication device" when combined with the other elements of claim 16. Accordingly, Applicant requests that the rejection of claim 16 under 35 U.S.C. § 103(a) be withdrawn. Additionally, claims 17-21 and 23 depend from claim 16 and are thus patentable over the cited combination of references for at least the same reasons as claim 16, and Applicant further requests that the rejection of claims 17-21 and 23 under 35 U.S.C. § 103(a) be withdrawn as well.

iv. Claims 24-29 and 32

With regard to claim 24, Applicant respectfully submits that the cited combination of Bork et al. in view of Barros et al. fails to disclose all of the elements of claim 24 as combined therein. Specifically, claim 24 has been amended to recite "wherein the list is configured to

Atty. Dkt. No. 035451-0169 (3707.Palm)

allow a user to select one of the indicators so that the user can share information with the corresponding local area computing device.” This element was previously recited in former claim 32 (canceled herein without prejudice), which depended from claim 24. The cited combination of Bork et al. in view of Barros et al. does not teach, disclose, or suggest “wherein the list is configured to allow a user to select one of the indicators so that the user can share information with the corresponding local area computing device” as included in the combination of elements of claim 24.

Bork et al. discloses only generally that the identification data “is entered manually or received through the cellular link when a certain number is called to page another like device 100” and that the identification data “is used throughout communications between the locating (paging) device 202 and the target (paged) device 204 as the paging device 202 approaches the paged device 204.” Col. 5, line 49 – col. 6, line 4. Thus, Bork et al. does not disclose that the identification code or codes are ever used for user selection of a particular device with which to communicate information. As to Barros et al., it fails to disclose any of the steps of claim 1 mentioned above that are lacking in Bork et al.

Thus, the cited combination of Bork et al. in view of Barros et al. does not teach, disclose, or suggest “wherein the list is configured to allow a user to select one of the indicators so that the user can share information with the corresponding local area computing device,” and particularly not as part of a “user interface for a handheld computer” when combined with the other elements of claim 24. Accordingly, Applicant requests that the rejection of claim 24 under 35 U.S.C. § 103(a) be withdrawn. Additionally, claims 25-29 depend from claim 24 and are thus patentable over the cited combination of references for at least the same reasons as claim 24, and Applicant further requests that the rejection of claims 25-29 under 35 U.S.C. § 103(a) be withdrawn as well.

Atty. Dkt. No. 035451-0169 (3707.Palm)

b. Rejection of claims 6, 14, 22, 30, and 31 based on Bork et al. in view of Barros et al.

In section 24 of the Office Action, claims 6, 14, 22, 30, and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bork et al. in view of Barros et al., and further in view of Kikinis et al. (U.S. Patent No. 6,389,290).

i. Claim 6

Claim 6 depends from claim 1. As explained above, the combination of Bork et al. in view of Barros et al. does not teach, disclose, or suggest the subject matter of claim 1. As to Kikinis et al., it fails to disclose any of the steps of claim 1 mentioned above that are lacking in the cited combination of Bork et al. in view of Barros et al. Because the cited combination of Bork et al. in view of Barros et al., and further in view of Kikinis et al. fails to disclose all of the steps of claim 1 as combined therein, and because claim 6 depends from claim 1, claim 6 is patentable over the cited combination of references for at least the same reasons as claim 1. Accordingly, Applicants request that the rejection of claim 6 under 35 U.S.C. § 103(a) be withdrawn.

ii. Claim 14

Claim 14 depends from claim 8. As explained above, the combination of Bork et al. in view of Barros et al. does not teach, disclose, or suggest the subject matter of claim 8. As to Kikinis et al., it fails to disclose any of the steps of claim 8 mentioned above that are lacking in the cited combination of Bork et al. in view of Barros et al. Because the cited combination of Bork et al. in view of Barros et al., and further in view of Kikinis et al. fails to disclose all of the steps of claim 8 as combined therein, and because claim 14 depends from claim 8, claim 14 is patentable over the cited combination of references for at least the same reasons as claim 8. Accordingly, Applicants request that the rejection of claim 14 under 35 U.S.C. § 103(a) be withdrawn.

Atty. Dkt. No. 035451-0169 (3707.Palm)

iii. Claim 22

Claim 22 depends from claim 16. As explained above, the combination of Bork et al. in view of Barros et al. does not teach, disclose, or suggest the subject matter of claim 16. As to Kikinis et al., it fails to disclose any of the elements of claim 16 mentioned above that are lacking in the cited combination of Bork et al. in view of Barros et al. Because the cited combination of Bork et al. in view of Barros et al., and further in view of Kikinis et al. fails to disclose all of the elements of claim 16 as combined therein, and because claim 22 depends from claim 16, claim 22 is patentable over the cited combination of references for at least the same reasons as claim 16. Accordingly, Applicants request that the rejection of claim 22 under 35 U.S.C. § 103(a) be withdrawn.

iv. Claims 30 and 31

Claims 30 and 31 depend from claim 24. As explained above, the combination of Bork et al. in view of Barros et al. does not teach, disclose, or suggest the subject matter of claim 24. As to Kikinis et al., it fails to disclose any of the elements of claim 24 mentioned above that are lacking in the cited combination of Bork et al. in view of Barros et al. Because the cited combination of Bork et al. in view of Barros et al., and further in view of Kikinis et al. fails to disclose all of the elements of claim 24 as combined therein, and because claims 30 and 31 depend from claim 24, claims 30 and 31 are patentable over the cited combination of references for at least the same reasons as claim 24. Accordingly, Applicants request that the rejection of claims 30 and 31 under 35 U.S.C. § 103(a) be withdrawn.

Conclusion

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Atty. Dkt. No. 035451-0169 (3707.Palm)

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date 9/8/2005By Chad E. Bement

FOLEY & LARDNER LLP
Customer Number: 26371
Telephone: (414) 297-5554
Facsimile: (414) 297-4900

Chad E. Bement
Attorney for Applicant
Registration No. 54,991